

**Remarks**

Claims 1-16 and 18 are pending in the application. Claims 8-11 and 18 are withdrawn. Claims 1-7 and 12-16 have been amended only for purposes of clarifying the inventive subject matter, and said amendments do not add any new subject matter within the meaning of 35 U.S.C. §101.

**Rejection Under 35 U.S.C. §112, 2d Paragraph**

The Examiner has rejected claims 1-7 and 12-16 under 35 U.S.C. §112, second paragraph, a being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant respectfully traverses this rejection. Claims 1-7 and 12-16 have been amended to clarify that the claimed coating is a composition. Further claim 3 has been amended to remove the phrase "on the basis of", and claim 14 has been amended to correct the lack of antecedent basis for the phrase "additional pigments".

With respect to the rejection of claims 1-2, 5, 7 and 13, the Examiner has alleged that these claims are invalid as vague, indefinite and containing functional language. Applicants submit that it has been established that there is nothing inherently wrong with defining an invention in functional terms. Functional language

does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

Furthermore, a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

The limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was held to be perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

In claims 1-2, 5, 7 and 13 the compositions are precisely defined and clearly set definite boundaries as to the patent

protection sought. Specifically, the claims fairly convey to one of ordinary skill in the art in the context in which it is used, the inventive subject matter of the present application. Accordingly, claims 1-2, 5, 7 and 13 are not invalid under 35 U.S.C. §112, second paragraph and respectfully request that the Examiner reconsider and withdraw this rejection.

Regarding the Examiner's comments with respect to claim 12, Applicants submit that claim 12 does further limit claim 1. As shown in Figure 2 and on page 9 of the instant specification, the angle of the pigments can increase the degree of spectral absorption. Therefore, a composition containing randomly oriented pigments would not provide as great a degree of absorption as a composition wherein the pigments have been oriented in accordance to claim 12. Accordingly, Applicants respectfully submit that claim 12 does further limit claim 1 and ask that the Examiner reconsider and withdraw this rejection.

**Rejection Under 35 U.S.C. §102(a)**

The Examiner has rejected claims 1-2, 4 and 6 as being anticipated by Binns et al., U.S. Patent 6,287,377. Applicants respectfully submit that Binns et al. is not prior art under 35 U.S.C. §102(a), because its publication date, September 11, 2001, does not antedate the priority dates, i.e., October 26, 1998; June 21, 1999 and October 25, 1999, and the U.S. filing date, i.e.,

April 25, 2001, of the present application. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection.

**CONCLUSION**

Applicant believes that in light of the foregoing the present application is in condition for allowance and earnestly solicits allowance of all pending claims by the Examiner. If the Examiner has any questions or wishes to discuss this matter, he is welcomed to contact the undersigned attorney.

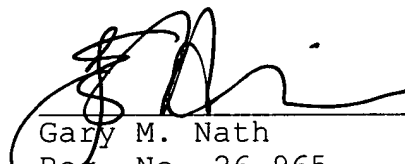
Respectfully submitted,

**NATH & ASSOCIATES PLLC**

Date:

Jan 4, 2005

**NATH & ASSOCIATES PLLC**  
1035 Fifteenth Street, N.W.  
Sixth Floor  
Washington, D.C. 20005  
Tel: (202) 775-8383  
Fax: (202) 775-8396

  
\_\_\_\_\_  
Gary M. Nath  
Reg. No. 26,965  
Tanya E. Harkins  
Reg. No. 52,993  
Customer No. 20529